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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JIE LIANG, ANTONIO ORTEGA, YOUNGJUN YOO and CHRISTOS CHRYSAFIS

Appeal No. 2003-0949
Application 09/164,517

ON BRIEF

MAILED
JUN 30 2004
U.S PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before JERRY SMITH, FLEMING, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7.

Invention

Appellants' invention relates to an image compression method with arithmetic coding of coefficient bitplanes and including

differing contexts and coefficient types from differing portions of the image. (Appellants' brief, page 2)

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method of encoding an image, comprising the steps of:

(a) decomposing an image into bitplanes; and

(b) arithmetic encoding the bitplanes with a context model from the neighboring bits in a bitplane and previous bits at the location in previous bitplanes.

References

The references relied on by the Examiner are as follows:

Boliek et al (Boliek)	6,141,446	Oct. 31, 2000 (filed September 30, 1997)
Rabbani et al (Rabbani)	5,442,458	Aug. 15, 1995
Healey et al (Healey)	5,357,250	Oct. 18, 1994
Oda	5,703,646	Dec. 30, 1997 (filed December 19, 1996)
Rust	5,901,251	May 4, 1999 (filed March 18, 1997)

Rejections At Issue

Claim 1 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Boliek and Rabbani.

Claims 2-3 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Boliek, Rabbani and Healey.

Claims 4-5 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Boliek, Rabbani and Oda.

Claims 6-7 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Boliek, Rabbani and Rust.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective detail thereof[1].

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 1-7 under 35 U.S.C. § 103.

Appellants has indicated that for purposes of this appeal all the claims stand or fall together.

I. Whether the Rejection of Claims 1-7 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

[1] Appellants filed an appeal brief on August 6, 2002. Appellants original brief filed on July 24, 2001, was fully replaced by the subsequent brief. The Examiner mailed out an office communication on September 18, 2002.

in the art the obviousness of the invention as set forth in claims 1-7. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

We find the Examiner met his initial burden of establishing a **prima facie** case of obviousness. (Rejection, paper number 11, pages 3-7) The Appellants responded that the Boliek patent is not prior art as its filing date was the same as Appellants' priority date for Provisional Application 60/060414 filed September 30, 1997. (Paper number 13, page 2) The Examiner then pointed out that the Boliek reference is a continuation-in-part

of U.S. patent 5966465 to Keith et al (Keith) and "US 5966465, has all the limitations the examiner used to reject claims 1-7." For these reasons, the Examiner viewed Boliek as entitled to an effective filing date of May 3, 1996. (Final rejection, paper number 14, page 2) Appellants repeat their above position before the Board in the brief at page 3. The Examiner responded with a more detailed analysis of where various limitations of Boliek can be found in the Keith reference. (Answer, page 8)

The question before us is whether and to what extent Boliek constitutes legally available prior art under 35 U.S.C. 102(e). Based on the evidence before us, we find Appellants' argument persuasive. In order to carry back the 35 U.S.C. § 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must support the invention claimed as required by 35 U.S.C. § 112, first paragraph. See MPEP § 2136.03 (IV).

The Examiner has shown where the Boliek limitations can be found in the parent application. However, there is no showing of how the disclosure of the Keith patent supports the invention of Boliek as required by 35 U.S.C. § 112, first paragraph. This showing is a prerequisite to showing where the Boliek limitations can be found in Keith. Our review of the claims in Boliek and the disclosure of the Keith patent shows that the invention

claimed in Boliek is not supported by the disclosure of the Keith patent. Therefore, we do not get to the step of reviewing where the Boliek limitations are found in Keith. "[P]ortions of the original disclosure cannot be found 'carried over' for the purpose of awarding filing dates, unless that disclosure constituted a full, clear, concise and exact description in accordance with § 112, first paragraph, of the invention claimed in the reference patent, else the application could not have matured into a patent, within the Milburn § 102(e) rationale, to be 'prior art' under § 103." **Ex parte Ebata**, 19 USPQ2d 1952, 1955 (Bd. Pat. App. & Int.).

Other Issues

At page 8 of the Examiner's Answer, there is an extensive discussion of where limitations of claim 1 can be found in the Keith patent (US 5,966,465). We have not decided the issue of the applicability of the Keith patent to a rejection under 35 U.S.C. § 103, as that issue is not before us.

Conclusion

In view of the foregoing discussion, we have reversed the rejection under 35 U.S.C. § 103 of claims 1-7.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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MICHAEL R. FLEMING) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
)
ALLEN R. MACDONALD) INTERFERENCES
Administrative Patent Judge)

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